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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,681	04/09/2002	Sergio Mantegani	217517US0PCT	8389

1200 7590 09/17/2003

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EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/17/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,681

Applicant(s)

MANTEGANI ET AL.

Examiner

Sudhaker B. Patel, D.Sc.Tech.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6 and 11-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 8
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) (in part) 1-6,11-17, drawn to compounds, composition, a method of use, and the first recited process of making the Formula $x\text{-CO-CH}(\text{CH}_2\text{-R}_2)\text{-CH}_2\text{-SO}_2\text{-Phenyl}$ substituted by R₁, wherein X is HO-NH- or HO-, R₁ and R₂ are non heterocyclic, drawn to R₂ as option (a). i.e. -S-Ar or -S-CH₂-Ar or option (b). i.e. -O-Ar.

Group II, claim(s) (in part) 1-6,11-17, drawn to compounds, composition, a method of use, and the first recited process of making the Formula $x\text{-CO-CH}(\text{CH}_2\text{-R}_2)\text{-CH}_2\text{-SO}_2\text{-Phenyl}$ substituted by R₁, wherein X is HO-NH- or HO-, and R₂ is option ©. i.e. R₂ is monocyclic hererocycle e.g. Pyrimidine, pyrazine, pyridazine, 1,2,5-triazine etc.

Group III, claim(s) (in part) 1-6,11-17, drawn to compounds, composition, a method of use, and the first recited process of making the Formula $x\text{-CO-CH}(\text{CH}_2\text{-R}_2)\text{-CH}_2\text{-SO}_2\text{-Phenyl}$ substituted by R₁, wherein X is HO-NH- or HO-, and R₂ is option (C) e.g. R₂ = 2,5-dioxo-1-imidazolidinyl or 2,4—dioxo-1-imidazolidineyl.

Group IV, claim(s) (in part) 1-6,11-17, drawn to compounds and other processes not included in above Groups I-III e.g. (1). When R₂ is 6-membered mono and 6:6-membered bicyclic heterocycle with 1 N i.e. Pyridine, quinoline, isoquinoline: (2). When R₂ is 5:6-membered fused bicyclo-heterocycle with 1N e.g. indole or 5-membered monocyclic ring, pyrrole: (3). When R₂ is imidazole/benimidazole, pyrazole, thiazole/benzothiazole, oxazole/benzoxazole, triazole, oxazole, and thiadiazole: (4). When R₂ is purine: (5). When R₂ is oxazolo- or thiazolo-pyridine: (6). When R₂ is tetrazolo-pyridazine. If this group is elected further restriction will be required as there are many unknowns. Additionally, a single species from the working examples with all variables exactly & definitely known must be disclosed.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

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corresponding special technical features for the following reasons: The only common structure in the compounds is X-CO—CH-CH₂-SO₂- which is not a patentably distinct, and the compounds formed by variable R₂-CH₂-, R₁ are chemically non-equivalent to each other as they represent different structures.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

-when R₂ is non-heterocycle;

-when R₂ is option (c). wherein Het is: (1). When R₂ is 6-membered mono and 6:6-membered bicyclic heterocycle with 1 N i.e. Pyridine, quinoline, isiquinoline: (2).

When R₂ is 5:6-membered fused bicyclo-heterocycle with 1N e.g. indole or 5-membered monocyclic ring, pyrrole: (3). When R₂ is imidazole/benimidazole, pyrazole, thiazole/benzothiazole, oxazole/benzoxazole, triazole, oxazole, thiadiazole: (4). When R₂ is purine: (5). When R₂ is oxazolo- or thiazolo-pyridine: (6). When R₂ is tetrazolo-pyridazine

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1,4, 5,6,11,12,14.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: They are different structures and are chemical non-equivalent to each other.

5. A telephone call was made to Mr. Spivak/ Dr.Blinker (Tel.703 413 3000) on 9/10/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.


Sudhaker B. Patel, D.Sc. Tech.
September 13, 2003.


MUKUND SHAH
SUPERVISORY PATENT
EXAMINER
ART UNIT 1624